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REMARKS**I. Status of Claims**

Claims 1-78 were originally filed in the application. In a first office action, claims 1, 2, 8-12, 19-20, 21-23, 29-32, 38-39, 40-41, 47-51, 57-58, 70-71, 59-61, 67-68 and 77-78 stood rejected under 35 U.S.C. §102(e) as being anticipated by Anderson, Jr. et al (US Patent No. 6,578,203). Claims 3-7, 14-18, 24-28, 33-36, 42-45, 52-56, 62-66 and 72-75 stood rejected under 35 U.S.C. §103(a) as being unpatentable over Anderson, Jr. et al. (US Patent No. 6,578,203) in view of Narayanaswami (US Patent No. 6,657,654). In response to the first office action, claims 6, 13, 15, 17/ 23, 25-27, 32-68, 71, and 73-78 were cancelled, and claims 1-5, 7, 9, 10-12, 14, 16, 18-19, 21-22, 24, 28-29, 31, 70 and 72 were amended to place them in better form for allowance. The prior art of record cited against the independent claims was distinguished.

After a second office action dated November 17, 2005, made final, claims 1-5, 7-12, 14, 16, 18-22, 24, 28-31, 70 and 72 were rejected, Applicants submitted an amendment and response, and requested reconsideration. Applicants amended claims 1-3, 5, 7 and 8, and cancelled claim 4. Claims 1-3, 5, 7-12, 14, 16, 18-22, 24, 28-31, 69-70, and 72 remained pending in the case.

On March 6, 2006, an advisory action was received from the office indicating that the amendment submitted by Applicant would not be entered because it raised new issues. Applicant filed an RCE on March 15, 2006 and included the un-entered amendment.

A first office action following the RCE filing was received from the office April 17, 2006 wherein claims 1-3, 5, 7-12, 14, 16, 18-22, 24, 28-31, 69, 70 and 72 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Anderson et al (US Patent #6,578,203) in view of Duhault (US Patent #6,456,334).

A Final Office Action, which is the subject of this response, was received on October 20, 2006. The rejection of claims 1, 2, 8-12, 18-22, 29-30, 31, 70 and 72 under 35 U.S.C. 103(a) as being unpatentable over Anderson et al in view of Duhault is maintained.

Applicants request reconsideration of the claims in light of the following remarks.

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II. Rejection of claim 1-3, 5, 7-12, 14, 16, 18-22, 24, 28-31, 69, 70 and 72 under 35 U.S.C. §103(a) as being unpatentable over Anderson et al. in view of Duhault.

Requirements for Prima Facie Obviousness

The obligation of the Examiner to go forward and produce reasoning and evidence in support of obviousness under 35 U.S.C. §103 is clearly defined at M.P.E.P. §2142:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

M.P.E.P. §2143 sets out the three basic criteria that a patent examiner must satisfy to establish a *prima facie* case of obviousness necessary for establishing a rejection to a claim under 35 U.S.C. §103:

1. some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
2. a reasonable expectation of success; and
3. the teaching or suggestion of all the claim limitations by the prior art reference (or references when combined).

A *prima facie* case of obviousness is further established when the Examiner provides:

1. one or more references
2. that were available to the inventor and
3. that teach
4. a suggestion to combine or modify the references,
5. the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art.

See: *In re Lueders*, 111 F.3d 1569-71, 42 USPQ2d 1481-84 (Fed Cir. 1997), and *In re Berg*, 320 F.3d 1310, 65 USPQ2d 2003, 2007 (Fed. Cir. 2003). It follows that in the absence of such a

prima facie showing of obviousness under 35 U.S.C. §103 by the examiner (assuming there are no objections or other grounds for rejection), an Applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443 (Fed. Cir. 1992).

Thus, in order to support an obviousness rejection under 35 U.S.C. §103, the Examiner is obliged to produce evidence compelling a conclusion that each of the aforementioned criteria has been met. If the Examiner fails to produce such a conclusion for each of the aforementioned criteria, the rejection must be withdrawn.

Examiner has failed to meet the *prima facie* case for any one of the following reasons.

A. Anderson et al is not a hand held device as required and taught by Applicants.

It is very important to the use of Applicants' invention as claimed that the device be a hand held device with a display capable of simultaneously displaying more than one video at a time. Because Anderson et al does not teach a hand held device as required by Applicants, and as also required by Duhault, for enabling the viewing of more than one video at a time, obviousness can not be met.

As admitted during the prosecution history by Examiner, "the Anderson device lacks the use of simultaneous displaying more than one in-play camera view." The Examiner has acknowledged during prosecution that patent references Anderson, Jr. et al (US Patent No. 6,578,203) alone does not teach the display of more than one in-play camera view on a hand held device. There is a very good reason for this. Anderson et al likely did not teach simultaneous video display because it was not obvious during the time of the Anderson et al patent application filing, but more importantly because Anderson was never anticipated to be operated as a "hand held device."

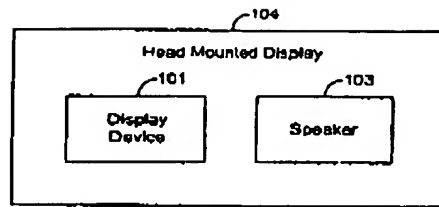
The Anderson et al device specifically refers to use of a "head mounted display" and is entitled "audio/video signal distribution system for Head Mounted displays." A user of a head mounted display form factor, would not be able to or interested in the *simultaneous* viewing of video captured from more than one video source. Regardless of what form factor was used by

Anderson et al, simultaneous display of more than one video and the ability to select a single for viewing on a display was not taught, hinted at or suggested by Anderson et al; but it is so important for the Examiner to realize that a combination of Anderson et al with Duhault *would never work*.

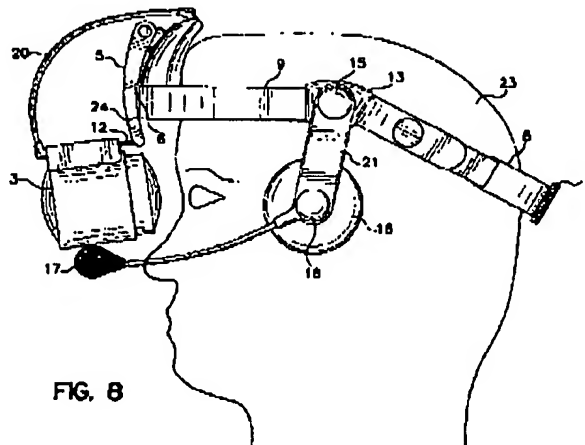
Examiner insists that Anderson et al teaches a hand held device similar in form factor to that claimed and taught by Applicants. Column 5, lines 34-38 are cited by Examiner as teaching a "portable device", but Anderson clearly teaches away from a PDAs, cellular telephones, and hand held televisions, that would only be supported by the user's hands during viewing usage, as compared to having to be worn on the user's head during usage. Rather than only picking a portion of the paragraph from Column 5 in Anderson et al. to support the rejection, Examiner should review a complete reading of Column 5, lines 22-38, which clearly states Anderson et al's intentions (copied below):

In the preferred embodiment, as shown by FIG. 4, the display screen 101 and speaker 103 are included within a head mounted display (HMD) 104, which is a well known device of the prior art. An example of a head mounted display suitable for implementing the present invention is fully described in U.S. Pat. No. 5,844,656, entitled "Head Mounted Display with Adjustment Components" and filed on Nov. 7, 1996, by Ronzani et al., which is incorporated herein by reference. Furthermore, when the combined signal 71 is transmitted via a coaxial cable, the receiver 75 may be located at a spectator's stadium seat or other convenient location. When the combined signal 71 is transmitted via a wireless transmitter, the receiver 75 is portable, and a spectator may carry the receiver 75 with him and choose where he would like to view the images and hear the sounds produced by the receiver 75.

Anderson et al's FIG. 4 also supports the limitation in form factor anticipated for use by the skilled as being a "head mounted display":

**FIG. 4**

Anderson et al specifically incorporate the “head mounted display” taught by Ronzani et al to suggest to the skilled a preferred embodiment. Specifically, the Anderson reference calls on support for a HMD into his specification by referring to U.S. Patent No. 5,844,656 entitled “Head Mounted Display with Adjustment Components” by Ronzani et al, which is specifically incorporated by reference in Anderson (i.e., see column 25, lines 25-30). A close review of FIGS. 1-9 in the Ronzani et al reference reveals that HMD 104 taught and suggested by Anderson **is not** a “hand held device.” FIG. 8 of Ronzani has been copied below to illustrate the type of device taught by Anderson.

**FIG. 8**

The HMD 20 taught by Ronzani et al, like Anderson's, must be attached to a person's head 23 during use. As indicated at column 3, lines 39-65 of Ronzani et al, a headband (8) is utilized to attach the HMD to a person's head (23). Additionally, Ronzani et al points out at column 2, lines 15-17 that it is "a further object of this invention to provide an adjustable HMD that is designed to be comfortably worn over a long period of time".

Thus, the HMD taught by Ronzani et al and Anderson is worn by or attached to a person's head and does not constitute a hand held device during operation. The Anderson device is not similar to the "hand held" device taught by Applicants, such as PDAs, cellular telephones, hand held televisions, which are specifically held in a user's hand during use for viewing video and are more conducive to enabling the user to view more than one video signal simultaneously on a display and for enabling selection of a single video image by the user.

Examiner only relies on a portion of the text in Anderson et al:

spectator may carry the receiver 75 with him and choose ³⁵
where he would like to view the images and hear the sounds
produced by the receiver 75.

to support a teaching of Applicants' hand held device. But it should be clear now given the above remarks, that one skilled in the art would not be motivated to combine Duhault with Anderson et al as suggested by the Examiner, because such a combination would not work during actual use.

It has been established that the Applicants' invention is used in the field of "entertainment" and enables simultaneous, real-time viewing/display of video images on displays associated with hand held devices. An important feature of Appellants' invention is simultaneous viewing of more than one video image captured by cameras at an entertainment venue on a single display associated with wireless, portable hand held devices. Another feature is in the ability for users to use a hand held device to view in-play camera views received at an entertainment venue together with other simultaneously transmitted video signals. Anderson et al would not support Applicants' teaching because Anderson et al is technically limited "head mounted" form factor. For the very same reason, Duhault would not benefit from using Anderson et al's teachings;

therefore, how can the skilled in the art expect to be motivated to combine Duhault with Anderson et al. The "skilled in the art" would not be motivated to make such a combination, because the combination of Anderson et al with Duhault simply wouldn't work. It would not be desirable for a user to view simultaneous images through binoculars. Why would a user want to view simultaneous images through the head mounted display taught by Anderson et al?

B. Duhault was not available to Applicants as a reference that taught a suggestion to combine or modify Anderson et al.

As outlined above, the Prima Facie case for obviousness is established when the Examiner provides:

1. one or more references
2. that were available to the inventor and
3. that *teach*
4. *a suggestion to combine or modify the references,*
5. the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art.

Applicants believe that they have already firmly established in their remark in section A of this response (above) that a suggestion to combine Duhault from a technical standpoint would fail by the very nature of the device form factors; but the suggestion to combine also independently fails because Duhault was never "*available*" to Applicants when they filed their patent application on December 13, 2001 in order to actually serve as a motivation to combine it with Anderson et al to arrive at the claimed invention. Availability is well supported by case law and a determination of availability must look at the date an application was filed in order to determine if it falls within the effective date of the amendment of Section 102(e) under "The Intellectual Property and Communications Omnibus Reform Act of 1999," Pub. L. No. 106-113, 4505, 113 Stat. 1501A-565, 590 (Nov. 29, 1999) (codified at 35 U.S.C. §102(e) (Supp. 2000)).

According to the Act, the effective date of the amendment (described in Section 4508) took effect “on the date that is 1 year after the date of the enactment of this Act and shall apply to all application filed under Section 111 of title 35, United States Code, on or after that date, and all application complying with section 371 of title 35, United States Code, that resulted from international applications filed on or after that date.” Thus, patent applications filed on or after November 29, 2000, which are published eighteen months later on or after May 29, 2002, unless an earlier priority date is claimed or early publication is requested, will fall under the Amendment of Section 102(e) under the Act.

Duhault (US Patent #6,657,654), which serves as the basis for Examiner's rejection, was filed on June 29, 1999 with the USPTO but was only made publicly available on September 24, 2002 to practically serve as a reference for the teaching the simultaneous display of video given the effective date of the portion of 35 U.S.C. §102(e) cited by Examiner and as specified under the Act.

Duhault does not specifically mention use in entertainment venues with in-play cameras, which is clearly why Anderson et al becomes such an important reference to use in combination. Duhault fails as a reference under 35 U.S.C. §103 because its effective “prior art” date is its publication date of September 24, 2002 given that it was filed before November 29, 2000. This effective date post dates the filing of Applicants’ patent application (December 13, 2001). In order to establish a prima facie case, the examiner is required to cite references that are public prior art as required under the Act when a combination is being made.

Given the applicability of 35 U.S.C. §102(e) as amended under the Act, Duhault was only first published as a patent on September 24, 2002. Applicants’ filed their patent application in December 2001; Therefore, Dehault would not have been available as a reference to those skilled in the art to be combined with Anderson et al as suggested by the Examiner.

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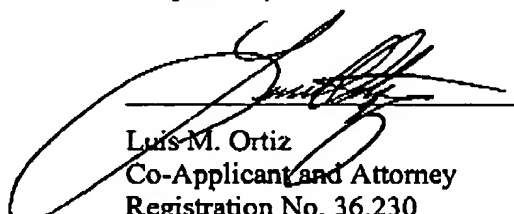
III. Conclusion

Applicants have responded to each and every rejection of the Official Action. Applicants submit that the above amendment and remarks place the pending claims in a condition for allowance. Applicants respectfully request the withdrawal of the rejections under 35 U.S.C. §103 based on the remarks. Reconsideration and early allowance of Applicants' application is also respectfully solicited.

The Examiner is respectfully requested to contact the undersigned representative to conduct an interview in an effort to expedite prosecution in connection with the present application should there be any outstanding matters that need to be resolved in the present application.

Respectfully submitted,

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